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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/910,354	07/20/2001	Kevin A. Jarrell	2003320-0032	2372
24280 7590 11/26/2010 CHOATE, HALL & STEWART LLP TWO INTERNATIONAL PLACE BOSTON, MA 02110				
EXAMINER VOGEL, NANCY TREPTOW				
ART UNIT		PAPER NUMBER		
1636				
NOTIFICATION DATE		DELIVERY MODE		
11/26/2010		ELECTRONIC		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

lbradley@choate.com  
patentdocket@choate.com  
jhess@choate.com

### Office Action Summary

**Application No.**

09/910,354

**Applicant(s)**

JARRELL ET AL.

**Examiner**

NANCY VOGEL

**Art Unit**

1636

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 07 September 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1, 2, 4, 5, 14-17 and 19-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 4, 5, 14-17, 19-21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/ISA/C3)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_
- Paper No(s)/Mail Date \_\_\_\_\_

### **DETAILED ACTION**

Claims 1, 2, 4, 5, 14-17, 19-21 are pending in the case.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 2, 4, 5, 12, 14-21 are rejected under 35 U.S.C. 102(e) as being anticipated by Harney et al. (US Patent 6,495,318).

This rejection is maintained essentially for the reasons set forth in the previous Office action, mailed 3/5/10. To recapitulate:

Harney disclose a method of preparing a DNA vector, comprising providing at least two collections of nucleic acid molecules that are DNA vector fragments, wherein each of the collections comprises alternative vector fragments to be included in the vector, wherein vector fragments within the first collection each comprise at least a first portion of a first vector element and a first portion of a second vector element (a first portion of an antibiotic resistance marker encoding gene, for instance) which first portion of the second vector element cannot alone provide a second vector element function (the function of antibiotic resistance); and vector fragments within the second collection

each comprise a second portion of the second vector element (a second part of an antibiotic resistance encoding gene for instance), which second portion of the second vector element also cannot alone provide the second vector element function, the first and second portions of the second vector element being selected and the vector fragments being designed such that when a vector fragment from the first collection is ligated with a vector fragment from the second collection the second vector element function is reconstituted, and mixing at least one vector fragment from each collection with one another under linkage conditions so that a hybrid molecule in which each of the fragments is linked together is produced. See Figure Fig. 1 and col. 1, lines 58-col. 2, line 15, and see col. 17, lines 15-23). The reference discloses that the selected nucleic acid molecules contain at least one overhang that is complementary with an overhang on at least one of the other selected molecules (col. 2, lines 33-41). The reference discloses the further introduction of the hybrid molecule (ie vector) into a cell (see col. 56, lines 18-23). The reference discloses that each nucleic molecule in each of said collections contains at least a portion of a vector element such as a promoter, selectable marker, replication origin, transcription terminator, etc. (Fig. 1 and column 7, lines 11-26). The reference discloses admixing under ligase conditions (see col. 17, lines 61-65). The vector fragments contain selectable or detectable genetic units (see Fig. 1). The reference discloses said method wherein the step of admixing further comprises admixing an isolated nucleic acid molecule containing insert sequence (ie the gene of interest in Fig. 1). The first vector element provides a first vector element function, such as a promoter (Fig. 1). The reference discloses that a marker gene may

be split between two of the components, which is reconstituted upon ligation of the two components (col. 17 lines 15-23). The first vector element may also be considered to be the half restriction enzyme site present at the left of the fragments shown in Fig. 1, and thus they alone cannot provide a first vector element function i.e. a complete restriction site. The first portion of the first vector element may alternatively be considered the promoter present on the first element shown in Fig. 1. It is noted that the specification defines a vector "element" as "a region of nucleic acid sequence that imparts a particular functional or structural characteristic upon the molecule" (page 8 of the specification). Furthermore, each of the fragments in Fig. 1 may be considered to comprise a first or second portion of a second vector element, which if nucleic acid is inserted between said first and second portion, would prevent creation of the "second vector detection element"; a vector detection element may be a particular pattern of nucleic acid fragments produced upon restriction, and an insertion of nucleic acids between two portions of the "second vector detection element" would not create said "second vector detection element". Furthermore, a selectable marker gene which is split between two components or fragments, would fail to function if interrupted by a DNA fragment inserted between the two components or fragments. Therefore, the claims are anticipated.

Applicants arguments filed 9/7/10 have been considered but have not been found convincing. Applicants have argued that significant sections of the Harney reference, i.e. the CIP application which resulted in US Patent 6,495,318, were added to the parent application, after the death of the sole inventor, Peter D. Harney, and that these

sections are those that are relevant to the alleged anticipatory disclosure. Applicant further argues that the attorney responsible for the CIP was the same attorney who drafted and prosecuted certain inventions of the present inventor Kevin Jarrell and was working with the present inventor on those inventions at the time when the Harney CIP was being prepared and filed. Applicant further argues that the material added to the Harney CIP application which resulted in 6,495,318, is identical or almost identical to material which was in earlier filed applications of the present inventor, Dr. Jarrell. While applicant's arguments have been considered, the rejection is maintained, since the examiner can only consider the Harney patent as valid prior art. Whether the anticipatory disclosure of the Harney patent was legitimately obtained from work performed, or concepts originated, by Dr. Harney before his death, is not a decision that is properly made by the examiner. It is noted that the examiner does not properly have access to the notebooks, experimental results, etc. of Harney which would provide support for the disclosure of the US Patent 6,495,318 on which the rejection is based. Therefore, the rejection is maintained.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to NANCY VOGEL whose telephone number is (571)272-0780. The examiner can normally be reached on 7:00 - 3:30, Monday - Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher Low can be reached on (571) 272-0951. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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/NANCY VOGEL/  
Primary Examiner, Art Unit 1636

NV  
11/18/10